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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.5US01	7081
23552	7590	03/09/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/175,589

Applicant(s)

JACOBSON, ANDREA M.

Examiner

Ella Colbert

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-22 are pending. Claims 1-22 have been amended in this communication filed 12/29/03 entered as Amendment E, paper no. 25.
2. The amendments to claims 1, 13, and 17 including dependent claims 2-12, 14-16, and 18-22 rejected under 35 U.S.C. 112 second paragraph still remains rejected under 35 U.S.C. 112 second paragraph for the reasons given below in the Response to Arguments.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 13, and 17 including dependent claims 2-12, 14-16, and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner does not find in Applicants' Specification or drawings "a minimum time period for compliance with the pre-determined retention policy" as claimed in independent claims 1, 13, and 17. It is unclear to the Examiner from reading the Specification and viewing the drawings what Applicants' mean by "a minimum time period" and a "predetermined retention policy." Applicants' are respectfully requested to clarify and to point out the limitation "a minimum time period " and a "pre-determined retention policy" to the Examiner and in the Specification and drawings.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 15, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,108,688) Nielsen in view of (US 5,245,532) Mourier and further in view of "[http:// www.ustrim.com/trim/page 31.htm](http://www.ustrim.com/trim/page 31.htm)", hereafter ustrim.

With respect to claim 1, Nielsen teaches, creating an electronic tag that uniquely identifies the electronic record, the electronic tag being associated with a minimum retention period for compliance with the pre-determined retention policy (col. 2, lines 5-30); sending the electronic record to a recipient (col. 2, lines 57-66.

Nielsen did not teach, denying a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag.

Ustrim teaches, denying a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag (page 1, "Retention & Disposal of Records" (also see fig. of screen shot). It would have been obvious to one having ordinary skill in the art at the time the invention was made to deny a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag and to modify in Nielsen because such a modification would allow Nielsen to determine when records should be sent to inactive storage, destroyed or archive.

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Nielsen did not teach, storing the at least one electronic tag in a central repository.

Mourier discloses, storing the at least one electronic tag in a central repository (col. 4, lines 12-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the at least one electronic tag in a central repository and to modify in Nielsen because such a modification would allow Nielsen to file the tag in a first storage(central repository) means or "Mail To Be Answered" file.

With respect to claim 2, Nielsen did not teach, further comprising deleting the electronic record and selectively deleting the at least one electronic tag.

Mourier discloses, further comprising deleting the electronic record and selectively deleting the at least one electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B). It would have been obvious to one having ordinary skill in the art at the time the invention was made to delete the electronic record and selectively delete the at least one electronic tag and to modify in Nielsen because such a modification would allow Nielsen to have the tag transferred into the "To Be Answered" file and deleted from the "To Be Assigned" file (purging the electronic record comprising the steps of deleting the electronic record).

With respect to claim 3, Nielsen teaches, further comprising storing the electronic record (col. 5, lines 24-34).

With respect to claim 4, Nielsen teaches, determining whether the request is consistent with the retention policy (col. 6, lines 43-50).

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With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale as given above for claim 4.

7. Claims 5-12, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Mourier and further in view of (US 5,786,817) Sakano et al, hereafter Sakano.

With respect to claim 5, Nielsen and Mourier did not teach, generating the reference code.

Mourier discloses, generating a reference code (col. 2, lines 61-64).

Sakano discloses, wherein the electronic tag is generated at least in part as a function of at least one of the registry, the user profile, and the reference code (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the electronic tag is generated at least in part as a

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function of at least one of the registry, the user profile, and a reference code and to combine Nielsen's creating an electronic tag that uniquely identifies the electronic record and Mourier's network user's user profile, reference code, and electronic tag with Sakano's the electronic tag being generated at least in part as a function of at least one of the registry, the user profile, and the reference code because such a combination would allow Nielsen and Mourier and Sakano's systems to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, Nielsen did not teach, reading electronic record. Mourier discloses, reading the electronic record (col. 4, lines 18-36). Sakano discloses reading the electronic record (col. 4, lines 9-16). Together Mourier and Sakano teach the claim limitations of claim 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to read the electronic record and to modify in Nielsen because such a modification would allow Nielsen to have a special memory section within his machine, memory section he may access on a read/write basis.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, Nielsen did not teach, wherein the index code identifies the contents of the electronic record and the recipient of the electronic record. Mourier discloses an index code identifying the (col. 4, lines 49-68, col. 5, lines 1-6, and col. 8, lines 24-34). Sakano discloses a classification code and an index code contents of the electronic record and the recipient of the electronic record (col. 4, lines 35-65).

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Together Mourier and Sakano teach the claim limitations of claim 8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an index code identifying the contents of the electronic record and the recipient of the electronic record and to modify in Nielsen because such a modification would allow Nielsen to have a command that sorts (index) the files by updated dates (index code).

With respect to claim 9, Nielsen teaches, wherein the index code identified the contents of the electronic record and the recipient of the electronic record (col. Col. 1, lines 7-41). The nature of E-mail does not entitle any patentable weight. The nature of the E-mail is a design choice.

With respect to claim 10, Nielsen did not teach, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record.

Mourier discloses, reading a stored electronic tag; and generating an electronic tag in response to accessing an electronic record (col. 7, lines 35-41). Sakano discloses an electronic record (col. 4, lines 1-16). Together Mourier and Sakano teach the claim limitations of claim 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to read a stored electronic tag and generating an electronic tag in response to accessing an electronic record and to modify in Nielsen because such a modification would allow Nielsen to have a subject and to have a message with the sender code (86156LAG0192 –as shown in col. 7 and 8, lines 59-68) and recipient code (86156LAG0200-as shown in col. 7 and 8, lines 59-68).

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

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With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,245,532) Mourier in view of (US 6,108,688) Nielsen further in view of "http://[www.ustrim.com/trim/page 31.htm](http://www.ustrim.com/trim/page%2031.htm)", hereafter ustrim.

With respect to claim 13, Mourier teaches, a computer system comprising at least one processor processor (col. 2, lines 26-32) and at least one memory (col. 3, lines 20-22).

Nielsen teaches, creating an electronic tag that uniquely identifies the electronic record, the electronic tag being associated with a minimum retention period for

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compliance with the retention policy (col. 2, lines 5-30); sending the electronic record to a recipient (col. 2, lines 57-66). Mourier did not teach, to deny a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag.

Ustrim teaches, to deny a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag (page 1, "Retention & Disposal of Records" (also see fig. of screen shot). It would have been obvious to one having ordinary skill in the art at the time the invention was made to deny a request to delete the electronic record before expiration of the minimum retention period associated with the electronic tag and to modify in Mourier because such a modification would allow Mourier to determine when records should be sent to inactive storage, destroyed or archive.

Nielsen did not teach, storing the at least one electronic tag in a central repository.

Mourier discloses, storing the at least one electronic tag in a central repository (col. 4, lines 12-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the at least one electronic tag in a central repository and to modify in Nielsen because such a modification would allow Nielsen to file the tag in a first storage(central repository) means or "Mail To Be Answered" file.

### ***Response to Arguments***

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10. Applicant's arguments filed 12/29/03 have been fully considered but they are not persuasive. The following are considered by the Examiner to be Applicant's main issues.

Issue no. 1: Applicant argues: the claims are supported by the disclosure in the specification at page 6, line 32 to page 7, line10, page 9, lines 9-11 and lines15-20, and page 19, lines 10-14 is not found to be persuasive. Response: The Examiner has carefully reviewed the specification at page 6, line 32 to page 7, line10 (the Examiner does not find any mention or suggestion of "a minimum time period"), page 9, lines 9-11 and lines15-20 (there does not appear to be any mention or suggestion of "a minimum time period" on this page and line numbers), and page 19, lines 10-14 (mentions "a specified period of time has elapsed" but does not state "a minimum time period"), Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant needs to incorporate the subject matter into the Specification and/or drawings or revise the wording of the claim limitation to be more in agreement with the wording in Applicant's Specification.

Issue no. 2; Applicant argues: Nielsen does not disclose or suggest a minimum retention period for compliance with a predetermined retention policy, as recited in the claims, either alone or in combination with Mourier and the cited art in combination, does not teach or suggest Applicant's invention as claimed has been considered but is not persuasive. Response: In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can

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only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Applicant's drawings and Specification of the disclosure do not suggest or disclose to the Examiner a "minimum retention period".

Conclusion: In this rejection of claim 1 and others above, for example under Section 103 of Title 35 of United States Code the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in Nielsen, Mourier, and Sakano. The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

**>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

*During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPO 541,550 (CCA 1969).<*

**Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


#### **Inquiries**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
E. Colbert  
March 8, 2004



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